

REMARKS

Claims 19, 23, 24, 26, 27, 29, 33-36, and 38 are pending in the instant application. Claims 1-18, 20-22, 25, 28, 30-32, and 37 stand canceled. Claims 19 and 27 have been amended to more clearly delineate the invention. No new matter has been added.

As an initial matter, Applicants wish to thank Examiner Desai for the courtesy of the telephonic interview held on January 31, 2011, with Christine O'Day and Dwight Kim.

Claim Rejection – 35 U.S.C. §112, first paragraph

Claims 19, 24, and 27 are rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking enablement regarding the term “solvates” and “hydrates.” Applicants disagree and respectfully traverse in view of the claim amendments herein. Claim 19 has been amended to delete the recitation of “solvates” and “hydrates.” The rejection is overcome and withdrawal of the rejection is respectfully requested.

Claim Rejection – 35 U.S.C. §112, second paragraph

Claims 19 and 27 are rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite regarding the term “derivatives thereof.” Applicants disagree and respectfully traverse in view of the claim amendments herein. Claims 19 and 27 have been amended to delete the recitation of “derivatives thereof.” The rejection is overcome and withdrawal of the rejection is respectfully requested.

Claim Rejection – 35 U.S.C. §103

Claims 19, 23, 24, 26, 27, 29, 33-36 and 38 remain rejected under 35 U.S.C. §103(a) as obvious over USSN 10/491,519 (US 2005/0096343) in view of Hubschwerlen et al. (WO 2004/096221).

It is submitted that the applied references may not properly be applied in a rejection under 35 USC §103(a). The Office Action acknowledges that the applied references have a

common inventor and constitute prior art only under USC §102(e). As in reference to the §103(a) rejection discussed above, Applicant submits that the subject matters of USSN 10/491,519, WO 2004/096221 and the claimed invention were, at the time the claimed invention was made, owned by the same entity (MORPHOCHEM AKTIENGESELLSCHAFT FUR KOMBINATORISCHE CHEMIE) or subject to an obligation of assignment to that entity. Consequently, USSN 10/491,519 and WO 2004/096221 are properly disqualified under §103(c) as ‘prior art’ under §103(a). See 35 U.S.C. 103(c)(1) and MPEP 706.02(l)(2).

Moreover, concerning WO 2004/096221, it is respectfully submitted that, given the effective filing date, the reference may not even qualify as ‘prior’ at all.

Hubschwerlen (WO 2004/096221) claims priority to two US provisional applications: USSN 60/466,945 (filed on April 30, 2003) and USSN 60/530,822 (filed December 18, 2003). The instant application also claims priority to USSN 60/530,822 (filed December 18, 2003). USSN 60/530,822 is therefore not prior art. A copy of the prior art document (USSN 60/466,945) was submitted in the response filed on July 12, 2010.

Applicants reiterate their contention from July 12, 2010, that the disclosure of USSN 60/466,945 does not provide for the compounds of the Applicants’ claims. Specifically, USSN 60/466,945 does not provide for a compound comprising a piperidine ring that is substituted at the 4-position with an oxygen-containing group. Page 2 of USSN 60/466,945 provides for a structural representation wherein “A” provides for a heterocycloalkylen group, as well as an ether linker. Elaboration of the heterocycloalkylen group can be found at least at pages 8-13 of USSN 60/466,945, wherein such a ring may be substituted F atoms.

Thus, USSN 60/466,945, the only document having a priority date earlier than the Applicants’ priority date, does not provide for the compounds of the Applicants’ claims.

Moreover, as discussed in the response filed on July 12, 2010, WO 2004/096221, or more specifically the priority application, does not teach or suggest that the pyridine ring can be substituted by an oxygen-containing group. Additionally, the Office Action has stated that USSN

10/491,519 does not have the R₄ group of the invention. Therefore, neither of USSN 10/491,519 or Hubschwerlen, whether alone or in combination, teaches or suggests the compounds of the Applicants' claimed invention.

The rejection is overcome and withdrawal of the rejection is respectfully requested.

Double Patenting Rejections

Applicants' claims are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over USSN 12/455,810 and USSN 10/491,519. Applicants disagree and respectfully traverse and will address the rejections upon the allowance of patentable subject matter.

In view of the above remarks, Applicants believe the pending application is in condition for allowance. Should any of the claims not be found to be allowable, the Examiner is requested to telephone Applicants' undersigned representative at the number below. Applicants thank the Examiner in advance for this courtesy.

The Director is hereby authorized to charge any credits or deficiency in the fees filed (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105, under Order No. 65507 (41925).

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Respectfully submitted,

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